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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,534	12/04/2003	Yin-Chun Huang	4444-0129P	5944
43831 7590 09/13/2007 BERKELEY LAW & TECHNOLOGY GROUP, LLP 17933 NW Evergreen Parkway, Suite 250 BEAVERTON, OR 97006			EXAMINER SINES, BRIAN J	
			ART UNIT 1743	PAPER NUMBER
			MAIL DATE 09/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,534	<b>Applicant(s)</b> HUANG ET AL.	
	<b>Examiner</b> Brian J. Sines	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) 22-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 18 – 21 are dependent upon from original claim 1. Newly submitted claims 22 – 32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: These additional apparatus inventions have different resistor configurations in comparison to the originally claimed invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22 – 32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Objections***

Claim 20 is objected to because of the following informalities: Claim 20 is grammatically incorrect. Claim 20 should be written: "... a portion of said reaction layer." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 5 and 18 – 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 – 5 and 18 – 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

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Regarding claim 1, it is unclear as to what structural limitation of the invention is involved in interacting with the specific component of a specimen in order to perform a measurement. The claim does not positively recite a reaction layer that is associated with the substrate for facilitating measurement. The reaction layer is considered a critical feature of the invented device and should be recited in the base claim. It is unclear as to how the reaction layer would be operatively associated with the component features, e.g., the operational and counterpart electrodes and the resistors, of the claimed instrument in order to function as recited. Claim 1 in line 13 recites "a biosensor," but it is unclear how this recited biosensor is involved in the operation of the claimed measuring instrument. The substrate and biosensor are interpreted as being two separate and distinct elements of the claimed instrument. It is unclear if the specimen is applied to the substrate or the biosensor.

In claims drawn to an apparatus statutory class of invention, the structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device (see MPEP § 2172.01). Furthermore, a limitation that is taught as critical to the invention in the specification should be recited in the claims (see MPEP § 2164.08c).

Regarding claim 2, the recitation that each of the recited electrodes *have* the same conductive material is indefinite. For example, are the electrodes comprised or made of the same conductive material, or are they coated with the same conductive material?

Regarding claims 4 and 5, these claims recite how the claimed device is intended to be used without positively reciting any structure that would facilitate the recited detection function. Therefore, these claims are considered indefinite. For example, does an incorporated reaction layer comprise a specific enzyme and other reagent components to facilitate the detection of either glucose or lactic acid?

Claim 1 recites the limitation "said chip" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "said reaction layer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "said enzyme" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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Claim 4 recites the limitation "said chip" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said chip" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "said chip" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Allowable Subject Matter***

Claims 1 – 5 and 18 – 21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, the cited prior art does not specifically teach the incorporation of a first resistor connected in series with the operational electrode, wherein the resistance of the first resistor is equal to or greater than the maximum resistance of the second resistor.

***Response to Arguments***

Applicant's arguments with respect to the present claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

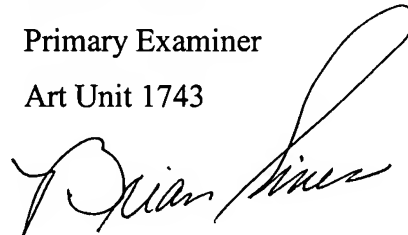
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian J. Sines  
Primary Examiner  
Art Unit 1743

A handwritten signature in black ink, appearing to read "Brian Sines", is written over the typed name and title.